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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,325	02/07/2001	Bruce S. Marks	A1019/20268	4861

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EXAMINER

NGUYEN, KIMBERLY T

ART UNIT PAPER NUMBER

1774

11

DATE MAILED: 02/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Crh

Office Action Summary

Application No.

09/778,325

Applicant(s)

MARKS, BRUCE S.

Examiner

Kimberly T. Nguyen

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This action is in response to the amendment submitted on December 2, 2002. It is acknowledged that claims 16 and 18 are canceled. Due to Applicants' amendments, the previous rejections of claims 1-3, 11, 14, and 16-17 under 35 USC 102(b) and of claims 4-10, 12-13, 15, and 18-20 under 35 USC 103(a) are withdrawn.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Due to Applicants' amendments and remarks, the previous rejections based upon 35 USC 112, 2nd paragraph of claims 1, 3-5, and 14-16 are withdrawn.

Claim Rejections - 35 USC § 103

Claims 1-15, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alder et al., U.S. Pat. No. 5,773,136.

Alder shows a polyolefin, opaque, pigmented, and biaxially oriented film comprising a heat-sealable layer, a non-voided intermediate layer (non-voided skin layer), an optionally voided base layer (core layer), a voided polymeric layer (opposed voided skin layer) (claims 1, 16, and 18 and column 1, lines 41-45) and a metal layer (column 4, lines 37-39) wherein the outer layers are thinner than the base layer (Examples 1, 2, 3, and 6). Alder shows that the outer surfaces of the film are corona discharge treated (column 4, line 60 to column 5, line 3). Alder shows in column 3, lines 59-65 that the layers of the film can be voided (i.e. polymeric layer) by comprising calcium carbonate (column 6, lines 32-37).

Art Unit: 1774

Though Alder shows that the amount of calcium carbonate causes the voiding (column 6, lines 33-36), Alder does not specifically show the concentrations of the calcium carbonate as in instant claims 2-5 or the thicknesses as in instant claims 12-13. However, such concentrations and thicknesses are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the concentrations and thicknesses, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. concentrations and thicknesses) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they control the level of voiding, mechanical strength, and opacity of the film. As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the film with the limitations of the concentrations and thicknesses since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alder et al., U.S. Pat. No. 5,773,136 in view of Murschall et al., U.S. Pat. No. 5,900,294.

Alder is relied upon as above for claims 1 and 17. Alder does not specifically show that the film can be used as a label as in instant claim 20. Murshall shows a white, opaque label comprising a base layer and at least one outer layer comprising calcium carbonate (claims 1-7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the film of Alder as a label since it is known that films of the composition of Alder and

Art Unit: 1774

Murschall can be used as labels since such films have unusually low heat-sealing temperatures (Murschall, column 7, lines 23-30).

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. Murschall et al., U.S. Pat. No. 5,900,294 is still used in the rejection of claim 20 to show that the film is known to be able to be used as a label.

Conclusion

Applicant's AMENDMENT necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

Application/Control Number: 09/778,325

Page 5

Art Unit: 1774

• If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen
Examiner
February 9, 2003

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